

REMARKS

Withdrawn Rejection

Applicants claim the same invention claimed in U.S. Patent 6,169,624, Godil. A rejection over Godil was advanced in the Office Action dated July 22, 2003. That Office Action was responded to with a Request for Reconsideration and related papers filed January 22, 2004. The outstanding Office Action dated June 29, 2004 is responsive to that Request for Reconsideration. In the outstanding Office Action, the Examiner has withdrawn the rejection over Godil. As Applicants claim the exact same invention as that claimed in Godil, and the rejection over Godil has been withdrawn, the necessary conclusion is that Applicants have established a conception and reduction to practice, as discussed in the Amendment of January, 2004, in advance of the filing date of Godil, that is, in advance of August 11, 1999. Applicants appreciate the Examiner's confirmation of the same.

REQUEST FOR RECONSIDERATION

All claims pending stand rejected as anticipated by U.S. Patent 6, 233,087, Hawkins, et al., (Claims 1-8) were obvious (Claim 9) over Hawkins in view of U.S. Patent 5,311,360, Bloom. The Examiner advances this rejection pursuant to 35 U.S.C. §102(e)/103. Pursuant to the provisions of 35 U.S.C. §102(e), Hawkins is available as of its filing date of December 18, 1998. Applicants have submitted Declarations in the above-captioned patent application, which were originally submitted pursuant to the provisions of Rules 608(b). The Declaration of the inventors is supported by a corroborating Declaration. The Declaration establishes that a grating light valve, which is a reflective light processing element, comprised of (1) a substrate, (2) a dielectric layer and (3) a conductive trace formed in the dielectric layer to allow charges trapped at the dielectric layer to escape, “particularly focused on trapped charges present on the surface of the dielectric layer” was conceived of and reduced to practice before December 18, 1998. Declaration of the Inventors, paragraph 3. That same paragraph further provides that the reflective light processing element “included a plurality of ribbons formed above the substrate and the conductive trace.” This Declaration, which the outstanding Office Action in no way questions or criticizes, thus demonstrates that a reflective light processing element on which Claim 1, the broadest claim of the above-captioned patent application, reads, was conceived of and reduced to practice prior to the effective date of U.S. Patent 6,233,087.

Pursuant to 37 C.F.R. §1.131, when the inventors file a Declaration establishing possession of the invention in advance of the date of the reference, the rejection must be withdrawn, unless it constitutes a statutory bar.

The Examiner has maintained the rejection, not on the basis that the Declaration is inadequate, but rather on the grounds that “none of the exhibits provided in the Declaration provide any test results to show that the device will work for its intended purpose.” Respectfully,

the rejection is in error as a matter of law, and should be withdrawn. The Examiner, in focusing only on the exhibits attached to the Declaration, and not the Declaration itself, has failed to follow the binding precedent of the United States Patent and Trademark's Board of Patent Appeals and Interferences, the Court of Appeals for the Federal Circuit, and its predecessor, the Court of Customs and Patent Appeals.

Initially, Applicants note that the sole basis for rejecting this showing that is otherwise adequate pursuant to the provisions of 37 C.F.R. §1.131 is an alleged lack of demonstration that the invention worked for the purpose for which it is intended. The Examiner, by express statement, is judging the adequacy of the showing according to the standards of interference practice, not the standards of 37 C.F.R. §1.131. This same rigorous proof of utility is not required. In re Eikmeyer, 602 F.2d 974, 202 USPQ 655, 660 (CCPA 1979). See also MPEP §715.07. Moreover, it is apparent that the device does work for its intended purpose. The device illustrated in the Declarations is the same device that it is addressed in the above-captioned patent application. The Examiner has not questioned the enabling nature of that disclosure.

Perhaps more importantly, however, the Examiner has ignored the plain statements of the Declaration, and focused solely on the exhibits. This is reversible error. This exact set of circumstances was addressed by the Board in Ex parte Ovshinsky, 10 USPQ.2d 1075 (BPAI 1989). The Board first noted that the declarations of the inventors "established conception of the claimed invention prior to the effective date of the reference." 10 USPQ.2d at 1077. The Examiner does not question Applicants conception, either. The Board went on to observe:

Apparently, the Examiner has dissected the evidence and considered only Exhibits A-D in the form of "notes" as having probative value. According the Examiner, these "notes" are appellants "proofs" and the "proofs" considered alone are insufficient to establish conception of the claimed invention prior to the effective date of the reference. This failure to give probative weight to the Rule 131 Declarations constitutes reversible error.

We point out to the Examiner that (1) all the evidence must be considered in its entirety, including the Rule 131 Declarations and accompanying exhibits, records and “notes”, (2) an accompanying exhibit need not support all the claim limitations but rather a missing feature may be supplied by the Declaration itself. Ex parte Swaney, 89 USPQ 618 (Pat. Bd. App. 1950), and (3) it is entirely appropriate for appellants to rely on a showing of facts set forth in the Rule 131 Declarations themselves, to establish conception of the invention prior to the effective date of the reference. This appellants have done. (Emphasis supplied).

Just as in Ovshinsky, the rejection herein ignores the competent declaration of record, and focuses solely on the exhibits. Just as in Ovshinsky, the rejection outstanding should be withdrawn, in light of the competent Declarations provided.

An example of the error committed in advancing the outstanding rejection can be identified in page 4 thereof. In referring to Exhibit E, the Examiner argues:

The Applicants assert that the schematics show a substrate, two sets of ribbons and gaps in-between with the physical structure reflected in the third schematic wherein the conductive trace goes from substrate contact to ribbon port. While the schematics provided show a plan view of a grating light valve with a plurality of ribbons and gaps in-between, and a reference to a conductive trace, none of the schematics show the combination of the structure recited, namely, that of a dielectric layer being formed on a substrate, and of a conductive trace formed on the dielectric layer so as allow charges trapped in the dielectric layer to escape as recited in Claim 1 of the instant application.

Outstanding Office Action, page 4. Yet, this specific statement does appear in the Declaration of the inventors, and they specifically reference the substrate, the dielectric, the ribbons, and the formation of the contacts for the “conductive trace connection” which is all that is required of the claim. It is unclear what the Examiner believes is missing. For further confirmation that the device prepared includes a substrate, which the Declaration notes is typically silicon, see Exhibit A, which describes a silicon substrate with a oxide dielectric layer thereover. As the Examiner acknowledges that there is a conductive trace formed with respect to the dielectric layer, and

contact is clearly established, according to precedent, the Declaration of the inventors submitted is adequate, pursuant to the provisions of 37 C.F.R. §1.131.

Applicants also note, page 5 of the outstanding Office Action, the observation that there is “no corroborating Declaration that confirms the subject matter described in the Declaration and Exhibits A-D.” Respectfully, the Examiner is reminded that corroboration is not a requirement to antedate a reference, unless that reference claims the exact same invention, when antedation is pursuant to 37 C.F.R. §1.608(b). While Applicants initially submitted their Declarations pursuant to the provisions of Rule 608(b) to precipitate an interference with Godil, and those Declarations are apparently affective for that purpose given the Examiner’s withdrawal of the rejection over Godil, there is no reason that the same Declaration is not adequate for the purposes of 37 C.F.R. §1.131.

Applicants further note, in any event, that a corroborating Declaration is of record in this case. Applicants submit herewith a copy of the Declaration of Berger filed, which confirms the work of the inventors. The fact that the Declaration was prepared for U.S. Patent Application Serial No. 10/029,875 in no way impacts its adequacy as a corroborating Declaration, were the same required by law.

Finally, Applicants note that the rejection of Claim 9 is overcome by establishing a date of invention in advance of U.S. Patent 6,233,087.

All claims pending stand directed to subject matter that Applicants have demonstrated, by their own Declaration, supported with contemporaneous evidence, that they conceived of, and made the subject matter of Claim 1 of the above-captioned patent application well in advance of the filing date of U.S. Patent 6,233,087. Pursuant to the provisions of 37 C.F.R. §1.131, this is sufficient to overcome the rejection. In accordance with 37 C.F.R. §1.608(b), that showing has been corroborated. Accordingly, the application is in condition for allowance, but for the

outstanding patent to Godil, and a Declaration of Interference therewith is respectfully requested.

Respectfully submitted,

PIPER RUDNICK LLP

A handwritten signature in black ink, appearing to read 'S. Kelber', is written over a horizontal line.

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